



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,758	12/03/2003	Roy Schoenberg	66729/P029US/10613663	4221

29053 7590 01/25/2007

DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.  
2200 ROSS AVENUE  
SUITE 2800  
DALLAS, TX 75201-2784

EXAMINER

LEWIS, CHERYL RENE A

ART UNIT

PAPER NUMBER

2167

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/726,758

Applicant(s)

SCHOENBERG, ROY

Examiner

Cheryl Lewis

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is in response to the applicant's communication received on October 13, 2006.
2. Claims 1-55 are presented for examination.
3. The applicant has amended claims 1-8, 21, 47, and 54 in the amendment received on October 13, 2006. The amendment received on October 13, 2006 also added new claim 55.
4. Applicants' arguments with respect to claims 1-55 have been considered but are deemed to be moot in view of the new grounds of rejection.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 9, 21, 29, 41, and 47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As follows:

The examiner acknowledges the amendments to claims 1 and 47. Although, claims 1 and 47 have been amended, these claims remain non-statutory because of the reasons set forth below in the 101 rejection.

Claims 1, 9, 21, 29, 41, and 47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1, 21, and 47 are

Art Unit: 2167

directed to searching desired data records, each data record comprises a text string, the data records have a field descriptor that defines specific data and the data records have a value descriptor that defines a field value.

Claims 9, 29, and 41 are directed to searching text strings associated with data records and generating a result to identify text-strings that include a value descriptor. The claimed inventions, as a whole must accomplish a **practical application**. That is, it must produce a **“useful, concrete, and tangible result.”** *State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. MPEP 2106*. In each of these cases the **result** a field descriptor defining a record data field and a value descriptor defining a value of a specific record field (claims 1, 21, and 47); and a result set that identifies text-strings that include a value descriptor (claims 9, 29, and 41). The claimed limitations are an abstraction as they are not **useful, concrete, and tangible**; they are not put in any tangible form and not useful because they are not presented in a way to provide some result that is of utility that may exist in the specification however no specific use is provided for in the claimed invention. Thus the claims are non-statutory and stand rejected under 101 as not **producing a “useful, concrete, and tangible result.”**

Independent claims 1, 21, and 47 are searching for desired data records, but what happens to the data records after the search is conducted and the records are found. Usually, a search results in a retrieval of data (data records), but what is actually missing from the claims is a retrieval step. Once the data (data records) has been retrieved, and then is the data (data records) being presented as output, display, etc.? What is the manipulation and/or transformation in the data that would bring about a

Art Unit: 2167

useful, concrete, and tangible result? At best, the claims are descriptive of the internal components of a data record. It is well known in the art of data processing that a record consists of data fields. The record is being descriptive of a field descriptor that defines a specific field of text with the data record and a value descriptor that defines a value associated with the specific data field. The two claim limitations "field descriptor" means and "value descriptor" means are not producing a useful, concrete, and tangible result. The "field descriptor" and the "value descriptor" means are only being descriptive about the internal storage fields that exist within a data record. Again, these claim limitations are only giving a name to components that are stored within fields of a data record.

As for claims 9, 29, and 41, these claims produce a first result set, however the result set is identifying text strings that consist of a value descriptor means. These value descriptors again are internal storage components of fields that exist within a data record. There should be a further step that should come after the "first result set" to identify how the initial search result would bring about a useful, concrete, and tangible result.

Thus, the dependent claims 2-8, 10-20, 22-28, 30-40, 42-46, and 48-55 are also rejected for being dependent upon the above recited independent claims, these claims are also rejected for the reasons set forth above.

**NAME OF CONTACT**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

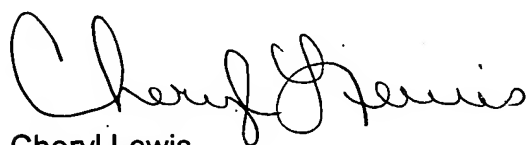
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2167

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Cheryl Lewis". The signature is fluid and cursive, with the first name "Cheryl" being more prominent than the last name "Lewis".

Cheryl Lewis  
Patent Examiner  
January 19, 2007